UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *10 September 2008*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-6 and 13-26* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-6 and 13-26* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the following communication: Amendment filed on

09/10/2008. **This action is made final.**

2.   Claims 1-6, 13-26 are pending in this case. Claims 1 and 15 are independent claims.

Claim Objections

3.   Claim 16 is objected to because of the following informalities: the term "the token"

recited in line 7 of the claim should be changed to "the physical code" to be consistent with the

language of the claim. Appropriate correction is required.

4.   Claims 23 and 24 are objected to because the term "RFID" needs to be spelled out.

Claim 23 is also objected because of typographical error: "an first RFID" should be changed to

"a first RFID". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner
> and process of making and using it, in such full, clear, concise, and exact terms as to
> enable any person skilled in the art to which it pertains, or with which it is most nearly
> connected, to make and use the same and shall set forth the best mode contemplated
> by the inventor of carrying out his invention.

6.   Claims 15-24 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention.

        Claim 15 recite the limitation "physical token having a token identifier". However, there

is no description in the specification to support the above-mentioned limitations.

Claims 16-24 and 26 are rejected as incorporating the deficiencies of the claim upon which it depends.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8.   **Claims 1-6, 13-22, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossweiler III et al (Patent No. US 7089288 B2; hereinafter Gossweiler) in view of Thorman et al. (Pub. No. US 2005/0131959 A1; hereinafter Thorman).**

As to claim 1, Gossweiller teaches:

A method for processing a physical token in a responsive environment to provide an association with a virtual document (e.g., see Fig. 1) comprising:

placing a physical sensor in proximity to the physical token (e.g., see col. 2 lines 9-20, col. 4 lines 61-67; wherein an electronic identification tag is affixed to each physical item);

placing the physical token in an instrumented association bin (e.g., col. 2 lines 21-38 and col. 5 lines 47-57; wherein the tag reader can write as well as read electronic tag identification numbers and data);

Gossweiller further teaches obtaining user selection data identifying the virtual document to register with the token (e.g., col. 5 lines 47-67, col. 6 lines 14-36 and lines 60-67; wherein a text document can be associated with the identification number of the electronic tag);

Gossweiller teaches creating a sensor model instance associating the physical sensor with the physical token and the virtual document (e.g., see col. 2 lines 56-67 through col. 3 lines 1-35, col. 6 lines 14-36 and lines 60-67; wherein each action is parameterized by a list of (name, value) pairs appropriate for that action);

While Gossweiller teaches the ability for the user to identify the virtual document to register with the token (e.g., col. 6 lines 14-36 and lines 60-67; wherein the user can easily add new tags and new types of actions; wherein one of the actions can be displaying a text document), Gossweiller does not teach launching a document browser application and obtaining user selection data from the document browser application to register with the token.

Thorman teaches a file browser that allows the user to identify files or documents for further manipulating (e.g., Figs. 4-5 and [0032]; wherein a file browser allow a user to easily identify files and directories). Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the feature of allowing the user to identify a document to register with the token taught in Gossweller to include the file browser feature as taught in Thorman to allow the user to select a document to register using a launching document browser. As suggested by Thorman, one would have been motivated to make such a combination is to make easier for the user to identify files or documents for further manipulating; thus, reduce the amount of time it takes the user to identify a document (e.g., see Thorman [0032]).

As to claim 15, Gossweiller teaches:

A method for processing a physical token in a responsive environment to provide an association with a virtual document (e.g., see Fig. 1) comprising:

placing a physical sensor having a sensor identifier in proximity to the physical token having a token identifier (e.g., see col. 2 lines 9-20, col. 4 lines 61-67; wherein an electronic identification tag is affixed to each physical item; wherein the electronic tag has a unique user accessible 39-bit identification number affixed to the physical item);

placing the physical token in an instrumented association bin, wherein the instrumented association bin is configured to read the sensor identifier and the token identifier (e.g., col. 2 lines 21-38 and col. 5 lines 47-57; wherein the tag reader can write as well as read electronic tag identification numbers and data);

obtaining sensor identifier data and token identifier data from the instrumented association bin (e.g., col. 2 lines 21-38; wherein the tag reader receives the identification number and passes this on to the computer system as an ASCII string);

Gossweiller further teaches obtaining user selection data identifying the virtual document to register with the token (e.g., col. 5 lines 47-67, col. 6 lines 14-36 and lines 60-67; wherein a text document can be associated with the identification number of the electronic tag);

Gossweiller teaches creating a sensor model instance associating the physical sensor with the physical token and the virtual document by using the obtained sensor identifier data, token identifier data and the user selection data (e.g., see col. 2 lines 56-67 through col. 3 lines 1-35, col. 6 lines 14-36 and lines 60-67; wherein each action is parameterized by a list of (name, value) pairs appropriate for that action);

While Gossweiller teaches the ability for the user to identify the virtual document to register with the token (e.g., col. 6 lines 14-36 and lines 60-67; wherein the user can easily add new tags and new types of actions; wherein one of the actions can be displaying a text document), Gossweiller does not teach launching a document browser application and obtaining

user selection data from the document browser application to register with the token. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have made this combination for the same reasons as set forth in the rejection of claim 1.

As to claims 2 and 16, Gossweiller further teaches setting a sensor name property (e.g., col. 5 lines 47-57, col. 6 lines 14-36).

As to claims 3 and 17, Gossweiller further teaches setting the sensor name property using an identifier associated with the document (e.g., col. 5 lines 58-67 through col. 6 lines 1-13, col. 6 lines 60-67).

As to claims 4 and 18, Gossweiller further teaches setting a sensor type property to indicate a physical sensor (e.g., col. 6 lines 60-67 through col. 7 lines 1-13).

As to claims 5 and 19, Gossweiller further teaches setting a sensor class property to indicate touch detection (e.g., col. 6 lines 60-67 through col. 7 lines 1-13).

As to claims 6 and 20, Gossweiller further teaches the sensor is attached to the token (e.g., see col. 2 lines 9-20, col. 4 lines 61-67).

As to claims 13 and 21, Gossweiller further teaches wherein the physical token comprises a card (e.g., col. 2 lines 9-20; electronic identification tag) and placing the physical token in an instrumented association bin comprises placing the card and the physical sensor in the instrumented association bin (e.g., col. 2 lines 21-38 and col. 5 lines 47-57; wherein the tag reader can write as well as read electronic tag identification numbers and data).

As to claims 14 and 22, Gossweiller further teaches before placing the card and the physical sensor in the instrumented association bin, attaching the physical sensor to the card (e.g., col. 1 lines 55-67 through col. 2 lines 1-8).

As to claims 25 and 26, Gossweiller further teaches a plurality of physical tokens, wherein each of the plurality of physical tokens is each associated with one of a plurality of virtual documents (e.g., col. 6 lines 14-36).

9.   Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gossweiler in view of Thorman further in view of Want et al. (published article, "Bridging Physical and Virtual Worlds with Electronic Tags"; CHI' 99; pages 370-377; hereinafter Want).

As to claim 23, Gossweiller and Thorman teach the limitations of claim 15 for the same reasons as set forth above. Gossweiller further teaches wherein the sensor identifier comprises an first tag and the instrumented association bin comprises a tag reader, further comprising reading the sensor identifier data from the first tag using the tag reader (e.g., col. 1 lines 55-67 to col. 2 lines 1-20; col. 5 lines 47-57). Gossweiller and Thorman do not teach RFID tag and RFID reader.

In the same field of endeavor of physical and virtual worlds using electronic tags, Want teaches RFID tag and RFID reader (e.g., see pages 371, 372). Accordingly, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the electronic tag and tag reader as taught by Gossweiller and Thorman to include the feature of the RFID tag and RFID reader of Want to achieve the claimed invention. As suggested by Want, one would have been motivated to make such a combination is because RFID tags has

no on-board power, thereby reducing the size and weight of the individual tags and eliminating

maintenance requirements (e.g., see Want page 371, right column, "SYSTEM OVERVIEW").

As to claim 24, Want teaches wherein the token identifier comprises an second RFID

tag, further comprising reading the token identifier data from the second RFID tag using the

RFID tag reader (e.g., pages 372, 373). Thus, combining Gossweiller, Thorman and Want

would meet the claimed limitations for the same reasons as set forth in claim 23 above.

Response to Arguments

10.   Applicant's arguments filed on 9/10/08 have been considered but are not persuasive.

a)   Applicant remarks with regard to claims 1 that the cited prior art of Gossweiller and

Thorman do not teach or suggest "physical sensor associated with a physical token" (e.g., see

Applicant's remark page 8).

In response, the examiner respectfully disagrees and submits that the features upon

which applicant relies (i.e., physical sensor associated with a physical token) are not recited in

the rejected claim(s). Although the claims are interpreted in light of the specification, limitations

from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). The examiner notes that the claim language requires: placing a

physical sensor in proximity to the physical token; this limitation is well-addressed as rejected

supra.

b)   Applicant remarks with regard to claims 1 that the cited prior art of Gossweiller and

Thorman do not teach or suggest "a physical sensor associated with the particular token and

virtual document so that it can report physical interaction such as touch applied to the token, but

merely describe id tags and physical items" and "instrumented association bin" (e.g., see

Applicant's remark page 8).

In response, the examiner respectfully disagrees. Gossweiller teaches a command such as open or print a particular electronic document can be associated with a physical ID tag (e.g., col. 6 lines 14-36, lines 60-67). Gossweiller teaches the command associated with the ID tag can be identified using positional information, applied pressure, force utilized in squeezing a pressure sensor (e.g., col. 7 lines 1-13). Therefore, Gossweiller teaches the feature of associating a physical sensor with a particular token and virtual document. Gossweiller further teaches the feature of an instrumented association bin (e.g., col. 2 lines 21-38 and col. 5 lines 47-57; wherein the tag reader can write as well as read electronic tag identification numbers and data). The examiner further notes that "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006,1009, 158 USPQ 275,277 (CCPA 1968)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TuyetLien (Lien) T. Tran whose telephone number is 571-270-1033. The examiner can normally be reached on Mon-Friday: 7:30 - 5:00 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TuyetLien T Tran/
Examiner, Art Unit 2179

/Weilun Lo/

Supervisory Patent Examiner, Art Unit 2179